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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,833	01/08/2002	Masanobu Okada	P/1071-1543	7681

7590

11/05/2003

Keating & Bennett  
10400 Eaton Place  
Ste. 312  
Fairfax, VA 22030

EXAMINER
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TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 11/05/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/042,833

Applicant(s)

OKADA, MASANOBU

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 6-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species 1A, drawn to figure 1 (claims 6-19) in Paper No. 8 is acknowledged. Upon further review of claims 6-19, the examiner agrees that claims 6, 10 and 16 are generic and claims 6-19 are read on Figure 1.

Election was made **without** traverse in Paper No. 8.

### ***Drawings***

2. Figures 5-6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claim 10 is objected to because of the following informalities: "proving" (claim 10, line 7) should be changed to: --providing--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 6, 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lonka (US 5,365,410).

Regarding claims 6, 10 and 16, Lonka discloses the method for removing an electromagnetic shielding case (cover 16) from a circuit substrate, said shielding case comprising a cover section for covering electronic component mounted on said circuit substrate, a plurality of leg sections for attaching said cover section to said circuit substrate each of said leg sections protruding from said cover section toward said substrate and being inserted in through holes provided in said substrate; and plurality of tool insertion openings 8, 12, 14, etc. provided on said cover section, said tool insertion openings corresponding to respective ones of said leg section (see Figs. 1-3); said method comprising steps: for each of said leg sections (necks 7, 11) inserting a cutting tool into a corresponding said tool insertion openings 8, 12 and 14 and cutting the corresponding leg sections 7, 11 away from said cover 16 section with said cutting tool (see the discussion at col. 2, lines 39-45); and after all of leg sections (necks ) have been cut away, removing the cover section (see the discussion at col. 4, lines 50-51). Note that the necks portions 7, 11 are read on the claimed leg sections of the present invention.

Regarding the limitation recites: " said shielding case comprising a cover section for covering electronic component mounted on said circuit substrate, a plurality of leg sections for attaching said cover section to said circuit substrate each of said leg sections protruding from said cover section toward said substrate and being inserted in through holes provided in said substrate; and plurality of tool insertion openings

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provided on said cover section, said tool insertion openings corresponding to respective ones of said leg section" (see preamble of claims 6, 10, and 16) is preamble limitation of the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7, 9-11 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lonka (US 5,365,410).

Regarding claims 6, 10 and 16. If argues that the Lonka does not teach the exact leg sections as recited in these claims. It would have been an obvious matter of design choice to choose any desired leg sections since applicant has not disclosed that these features as recited in each of the above claims are critical, patentably distinguishing features and it appears that the invention would perform equally well with the leg configurations having neck's portions as shown in the prior art reference (see Lonka's Figs. 3A and 3B).

As applied to claims 7 and 11, it is inherently to remove the cut away leg portions from the circuit substrate.

As applied to claims 9 and 13-15, regarding the provided opening and an associated inserting of a cutting tool to cut from one to the other of said pair of openings. It would have been an obvious matter of design choice to choose any desired cutting pattern including the cutting tool to cut from one of the tool inserting openings to the other of the tool inserting opening since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the cutting concept as suggested by the prior art reference (see col. 2, lines 43-45 of Lonka).

Limitations of claim 14-15 are also met as the above discussion.

As applied to each of claims 17-19, regarding the provided opening and an associated inserting of a cutting tool to cut from one to the other of said pair of openings and similar limitations recited in these claims. It would have been an obvious matter of design choice to choose any desired cutting pattern including the cutting tool to cut from one of the tool inserting openings to the other of the tool inserting opening since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the cutting concept as suggested by the prior art reference (see col. 2, lines 43-45 of Lonka).

Limitations of claims 18-19 are also met as the above discussion.

8. Claims 8, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lonka (US 5,365,410) in view of Applicant Admitted Prior Art (APA) see Applicant's Specification pages 2-3.

Regarding claims 8 and 12, Lonka as applied and relied upon above do not teach the step of melting the solder fixing the leg sections to the circuit substrate and thereby removing the leg portions from one to the other said pair of openings. APA teaches the concept above (see APA's discussion at pages 2-3). Therefore, it would have been an obvious to one ordinary having skill in the art at the time the invention was made to employ the APA's teaching of melting the solder for removing the leg portions from the circuit substrate onto the invention of Lonka in order to remove the unwanted leg sections from a desired circuit substrate by using the available techniques.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the leg sections from the circuit substrate by melting the solder, since it has been held that a mere reversal of the solder process by the melting process to separate and remove the leg sections from the associated structure involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Limitation of claim 12 is also met as the discussion above (see APA's pages 2-3).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art teaching of shield cover for PCB.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to be 'M. H. H.', with a horizontal line extending from the end.

Examiner Group 3700

mt